Appl. No. 08/924,785
Amdt. Dated Sept. 29, 2003
Reply to Office Action of July 1, 2003

CISCO-0193

REMARKS

Claims 13, 40-44, and 47 have been amended to further particularly point out and distinctly claim subject matter regarded as the invention.

Claims 26 and 61 have been newly canceled, without prejudice.

With this paper, claims 13-24 and 40-60 are pending with no claim allowed. Claims 13, 40-44 and 47 are independent claims.

The 35 U.S.C. § 103 Rejection

Claims 13-15, 17-24, 26, 40-43, 45, and 46 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Madany* (US 5,922,050) in view of *Beard* (US 6,067,577). Claim 16 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Madany* (US 5,922,050) in view of *Beard* (US 6,067,577) in further view of *Gish* (US 5,768,510). Claims 44 and 47-61 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Madany* (US 5,922,050) and *Beard* (US 6,067,577) in view of *Gish* (US 5,768,510) in further view of *Nakagawa et al.* (US 5,832,911). These rejections are respectfully traversed.

Initially it is noted that claims 26 and 61 have been canceled rendering the rejections with respect to these claims moot.

Generally, the Office Action states that *Madany* discloses or suggests most of the claim elements and limitations and that *Beard*, *Gish*, and *Nakagawa* disclose or suggest the rest. However, the rejections make a leap of knowledge that is not supported by the prior art.

As noted in the Field of the Invention section, *Madany* is directed to providing "...a system for permitting low-cost devices to be controlled by programs contained in the device." *Madany* later concludes at the end of the Background section that "[t]herfore, a mechanism is

Appl. No. 08/924,785
Amdt. Dated Sept. 29, 2003
Reply to Office Action of July 1, 2003

CISCO-0193

necessary to permit a low-cost device to be controlled by an application program [such as an applet] requiring a significant amount of computing hardware, yet maintaining a relatively low cost for the device." (Col. 2, lines 4-7) *Madany* accomplished this result by connecting the low-cost devices 16, 18, and 20 to a computer 10 over a network 14. (See FIG. 1) He then uses the computer 10 to do all of the significant processing. In effect this concentrates the system expense into the computer 10 while allowing the devices 16, 18, and 20 to remain low-cost. The basic assumption being that most people already have a computer available that could be used in this home automation application as well as other unrelated applications.

With respect to FIG. 2, the device is described by *Madany* as including a processor 22, a read only memory (ROM) 24, and a random access memory (RAM) 26. "Processor 22 may be an inexpensive processor capable of performing basic control functions and communication functions across the network. Similarly, ROM 24 and RAM 26 may be relatively small to reduce the overall cost of the device." (Col. 3, lines 49-53) Example devices include light switches, televisions, radios, and door locks. Later, *Madany* describes the ROM 24 as storing an application program or applet. However, "[t]his applet cannot be executed by processor 22 due to the inadequate processing resources of the processor." (Col. 4, lines 27-29) (See also claims 1, 12, and 17 containing the limitation "unable".)

This is where the leap of knowledge comes into play. While *Madany* does not rule out more expensive and sophisticated devices, he only discloses storing an applet on a device with inadequate processing resources to run it. The Office Action then extrapolates this simple example to all possible devices no matter how expensive or sophisticated without prior art description for support. The processing power of a light switch can hardly be compared to that

Appl. No. 08/924,785
Amdt. Dated Sept. 29, 2003
Reply to Office Action of July 1, 2003

CISCO-0193

of the claimed "network device" having "a network device control software program" executing

on it. Further, simply storing data in a memory can hardly be compared with the complexity of

the claimed "embedding" of data in an executable program. Recall that "[i]t will be appreciated

that the downloadable unit code 320 is embedded in the binary file 300 so that the downloadable

units 190 can be extracted from the software program 180 while the software program 180 is

executing." (Specification page 12, lines 19-22) This level of expense and sophistication is

beyond anything that is described in detail by *Madany*. So limited, the prior art can not be said

to render the claimed invention obvious.

In view of the above, it is respectfully asserted that the claims are now in condition for
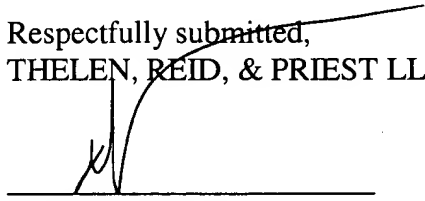
allowance.

Request for Allowance

In view of the foregoing, reconsideration and an early allowance of this application are

earnestly solicited.

If any matters remain which could be resolved in a telephone interview between the

Examiner and the undersigned, the Examiner is invited to call the undersigned to expedite

resolution of any such matters.

Respectfully submitted,
THELEN, REID, & PRIEST LLP

Dated: September 29, 2003

David B. Ritchie
Reg. No. 31,562

Thelen, Reid, & Priest LLP
P.O. Box 640640
San Jose, CA 95164-0640
(408) 292-5800